



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/687,219

10/15/2003

Calvin Wang

021756-002700US

8072

51206 7590 03/27/2007
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

MOUZON, LAJUANIA N

ART UNIT

PAPER NUMBER

2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

03/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/687,219

Applicant(s)

WANG ET AL.

Examiner

La Juania N. Mouzon

Art Unit

2109

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/29/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 10/29/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 300. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

4. The disclosure is objected to because of the following informalities: ¶0036 last line should read, "AMM 102 includes an action determiner 302, an information storer 304, **a message communicator 305**, and a message generator 306."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 6 recites the limitation "the device information" in the first sentence. There is insufficient antecedent basis for this limitation in the claim. For further review, of this application, the Examiner will interpret this claim as being further limiting claim 5.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-8, 11-17, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Arneson et al. (US PGPub 2001/0056508) filed on 5/11/2001 and published on 12/27/2001.

Figures 2, 3, 5, and 7 of Arneson et al. are reproduced below.

10. In regards to claim 1 Arneson et al. disclose, A method for messaging with devices in order to determine one or more actions to perform, the method comprising:

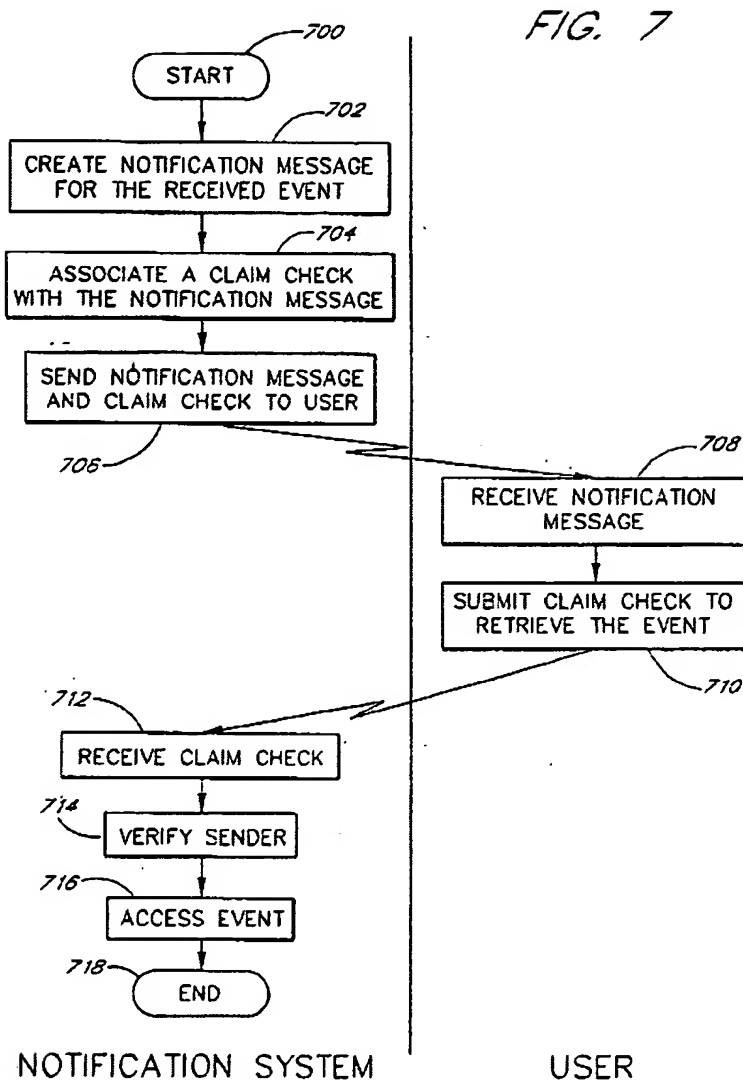
- a. storing information for a message, the stored information comprising action information corresponding to the one or more actions (**¶0056, teaches that any information for a message is stored in the notification database.**);
- b. sending a message to a device including a message identifier an one or more action identifiers corresponding to the one or more actions (**Fig. 7 # 706 and ¶0011, teaches sending a message including a message identifier and an action identifier. Both identifiers are defined as a claim check (¶0011 & ¶0083)**);
- c. receiving a response message from the device, the response message including an action identifier in the one or more action identifiers and the

message identifier (**Fig. 7 #712 and ¶0011, teaches receiving a response message from the device.);**

d. determining the stored information using the message identifier (**Fig. 7 #716 and ¶0087, teaches determining the stored information using the message identifier.);**

e. determining action information for the action in the stored information using the action identifier (**¶0012, teaches determining the action information from the stored information.);**

f. and performing the determined action using the action information (**¶0012 and ¶0087 , teaches performing the determine action.).**



11. In regards to claim 3 Arneson et al. disclose, wherein the sent message comprises a text-based message (¶0069, teaches that the sent message comprise a **text- message**) and the response message comprises a text-based message (¶0068, teaches receiving a SMTP message and others from the device. According to Microsoft Computer Dictionary 5th Ed., SMTP is define as a protocol used on the Internet to route e-mail. Likewise email is defined as an electronic text message.).

Art Unit: 2109

12. In regards to claims 4 and 14 Arneson et al. disclose, further comprising sending a result of the performed action to the device (**¶0012, teaches sending a result of the performed action to the device by reading the message to the user.**)

13. In regards to claim 5 Arneson et al. disclose, determining device information associated with the response message, wherein the message identifier and the device information are used to determine the stored information (**Fig. 3 and ¶0053 teaches, determining device information associated with the response message, wherein the message identifier and the device information are used to determine the stored information.**)

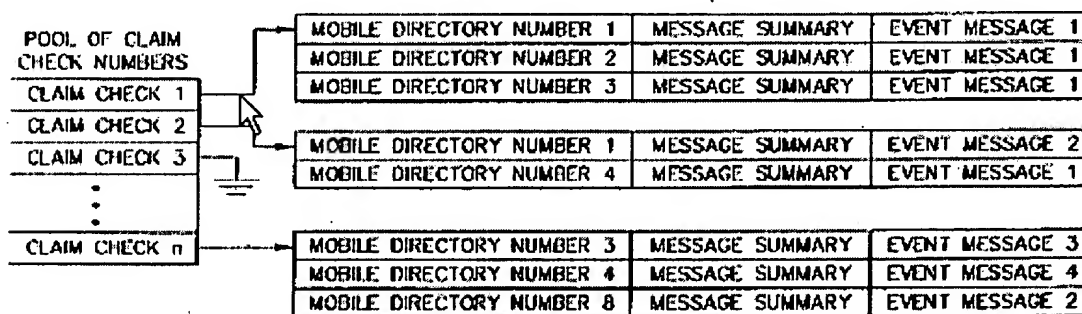


FIG. 3

14. In regards to claim 6 Arneson et al. disclose, wherein the device information comprises at least one of information specific to a device and information specific to a user (**¶0053, teaches that the mobile number is both user and device specific.**)

15. In regards to claim 7 Arneson et al. disclose, wherein the device comprises a mobile device (**¶0053, teaches whereas the number of the device of communication is a mobile number, therefore making the device a mobile device.**).

16. In regards to claim 8 Arneson et al. disclose, a method for messaging with devices in order to determine one or more actions to perform, the method comprising:

g. storing information on how to perform one or more actions (**¶0072, teaches that any information for performing actions is stored in the notification database.**);

h. sending a message to a device including information identifying the one or more actions (**Fig. 7 # 706, as shown above on pg. 6, and ¶0011, teaches sending a message including a message identifier and an action identifier. Both identifiers are defined as a claim check (¶0011 & ¶ 0083);**

i. receiving a text message from the device including information identifying a desired action in the one or more actions (**¶0068, teaches receiving a SMTP message and others from the device. According to Microsoft Computer Dictionary 5th Ed., SMTP is define as a protocol used on the Internet to route e-mail. Likewise email is defined as an electronic text message.**);

j. determining stored information on how to perform the desired action using the information specifying the desired action (**¶0070-¶00701, teaches determining stored information on how to perform the desired action using**

the information specifying the desired action. Based on the fact that what was determined can cause for the system to prompt for the user to do other actions.);

k. and causing the determined action to be performed using the information on how to perform the desired action (**¶0070, teaches performing the actions based on the said information determined.**).

17. In regards to claim 11 Arneson et al. disclose, wherein the sent message comprises a plain-text message (**¶0069, teaches whereas the sent message is of plain-text message.**).

18. In regards to claim 12 Arneson et al. disclose, wherein the text message comprises a plain-text message (**¶0068, teaches whereas the text message is a plain-text message.**)

19. In regards to claim 13 Arneson et al. disclose, wherein determining the stored information comprises using a message identifier for the received message to determine the stored information (**Fig. 3, shown above on pg. 7, and ¶0053 teaches, determining the stored information comprises using a message identifier for the received message to determine the stored information.**).

20. In regards to claim 15 Arneson et al. disclose, A device for generating and processing messages to determine actions to perform, the device comprising:

- l. a message generator configured to generate a message identifying one or more actions and to send the generated message to a device (**¶0017-¶0019, teaches a message generator configured to generate a messages);**
- m. an information storer configured to store information associated with the identified one or more actions (**Fig. 5 #510 and ¶0072, teaches an information storer in the form of the notification database.);**
- n. a receiver configured to receive a response message from the device, wherein the response message identifies an action in the one or more actions identified in the message sent to the device (**¶0070, teaches a receiver configured to receive a response message from the device, in the form of the event retrieval module, as shown in fig. 5 #508);**
- o. an action determiner configured to determine stored information for the identified action (**¶0070, teaches an action determiner configured to determine stored information for the action, in the form of the event retrieval module, as shown in fig. 5 #508.);**
- p. and an action performer configured to cause the action to be performed using the determined stored information (**¶0070, teaches an action performer configured to cause the action to be performed using the determined stored information, in the form of the event retrieval module, as shown in fig. 5 #508.).**

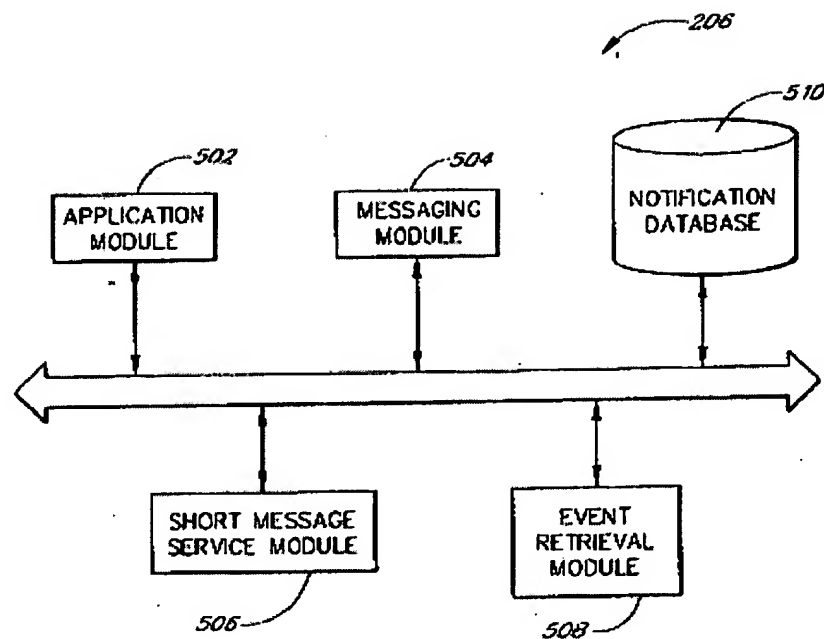


FIG. 5

21. In regards to claim 16 Arneson et al. disclose, wherein the generated message comprises a text message (**¶0069, teaches a short message service module that is configured to transmit text-messages.**).

22. In regards to claim 17 Arneson et al. disclose, wherein the response message comprises a text message (**¶0068, teaches receiving a SMTP message and others from the device.**).

23. In regards to claim 19 Arneson et al. disclose, wherein the action determiner determines the stored information using at least one of a message identifier for the response message to and information specific to the response message (**Fig. 3, shown**

on pg. 7 and ¶0053 teaches, whereas the action determiner determines the stored information using at least one of a message identifier for the response message to. Whereas ¶0071 teaches that the information is specific to the response message.).

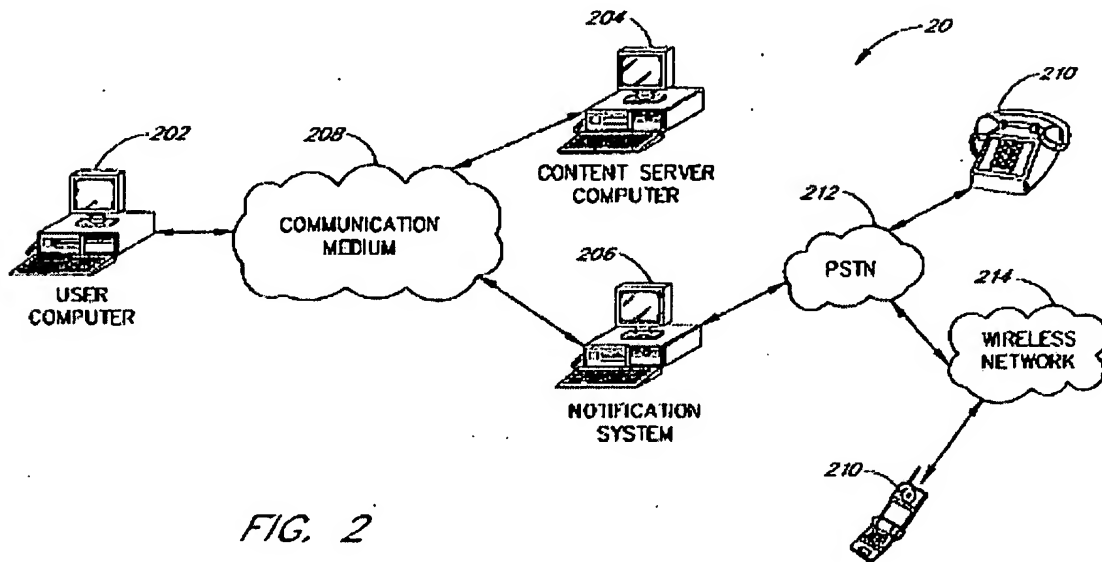
24. In regards to claim 20 Arneson et al. disclose, wherein the information specific to the response message comprises information specific to a user (¶0071, teaches that the information is user specific.).

25. In regards to claim 21 Arneson et al. disclose, a system configured to perform actionable messaging, the system comprising:

- q. one or more devices (Fig. 2 below #206 and #204, and ¶0036-¶0037, teaches a system comprising one or more devices.);
- r. an application configured to perform actions (Fig. 2 below #206, teaches a notification system configured to perform actions as state above in ¶10.) ;
- s. and an actionable message device configured to communication with the one or more devices and the application, the device comprising (Fig. 2 below #206 and ¶0036 , teaches a actionable message device configured to communication with the one or more devices and the application, as show below by the connection of #206 to #210 through #212. Likewise #206 connected to #210 through #214 via #212.) :

- i. a message generator configured to generate a message identifying one or more actions and to send the generated message to a device (**¶0017-¶0019, teaches a message generator configured to generate a messages);**
- ii. an information storer configured to store information associated with the identified one or more actions (**Fig. 5 #510, as shown on pg. 11, and ¶0072, teaches an information storer in the form of the notification database.);**
- iii. a receiver configured to receive a response message from the device, wherein the response message identifies an action in the one or more actions identified in the message sent to the device device (**¶0070, teaches a receiver configured to receive a response message from the device, in the form of the event retrieval module, as shown in fig. 5 #508 on pg. 11);**
- iv. an action determiner configured to determine stored information for the identified action (**¶0070, teaches an action determiner configured to determine stored information for the action, in the form of the event retrieval module, as shown in fig. 5 #508 on pg. 11.);**
- v. and an action performer configured to cause the action to be performed using the determined stored information (**¶0070, teaches an action performer configured to cause the action to be performed**

using the determined stored information, in the form of the event retrieval module, as shown in fig. 5 #508 on pg. 11.).



26. In regards to claim 22 Arneson et al. disclose, wherein the one or more devices comprise mobile devices (§0037 teach where the devices can be mobile devices.).

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

29. Claims 2, 9, 10, 18, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Arneson et al. (US PGPub 2001/0056508) filed on 5/11/2001 and published on 12/27/2001 as applied to claims 1, 8, 15, and 21 above, and further in view of Guan (US PGPub.2001/0027472) filed on 3/26/2001 and published on 10/4/2001.

30. In regards to claim 2 Arneson et al. do not teach, wherein the action information comprises information compatible with a web-based application, wherein the web-based application is used to perform the action.

31. In the same field of endeavor Guan teaches that the web-based application is used to perform actions and the action information being web-base compatible (**¶0054**).

32. Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Arneson et al. event Notification system with Guan's teaching as discussed above to allow for the capability of creating web pages that are customized to the user preferences for the ease of easy viewing for the end user.

33. In regards to claim 9 Arneson et al. do not teach, wherein the information on how to perform the one or more actions comprises web-based information.

34. In the same field of endeavor Guan teaches the information for processing the actions are web-based instructions (**¶0044-¶0052**).

35. Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Arneson et al. event Notification system with Guan's teaching as discussed above to allow for the capability performing the information in a web-base environment to allow the user the ability to view the information in a web-base environment.

36. In regards to claim 10 Arneson et al. do not teach, wherein the web-based information comprises a URL.

37. In the same field of endeavor Guan teaches the information comprises a URL (**¶0049**).

38. Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Arneson et al. event Notification system with

Guan's teaching as discussed above to allow for the capability of having an address associated with an action for locating the specific action that user would like to invoke.

39. In regards to claim 18 Arneson et al. do not teach, wherein the one or more actions comprise web-based actions.

40. In the same field of endeavor Guan teaches where the actions comprise web-based actions (**¶0044-¶0052**).

41. Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Arneson et al. event Notification system with Guan's teaching as discussed above to allow for the capability of executing the actions dynamically therefore eliminating possible human error.

42. In regards to claims 23 and 24 Arneson et al. do not teach, wherein the mobile devices are configured to receive and send messages exclusive of web-based messages.

43. In the same field of endeavor Guan teaches where are mobile devices are configured to receive and send message of web-based messages (**¶0042 & ¶0053**).

Art Unit: 2109

44. Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Arneson et al. event Notification system with Guan's teaching as discussed above to allow for the capability of synchronizing information with the database to keep the all information updated.

45. In regards to claim 25 Arneson et al. do not teach, wherein the application comprises a web-based application.

46. In the same field of endeavor Guan teaches that the application is a web-based application (~~¶0044-¶0052~~).

47. Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Arneson et al. event Notification system with Guan's teaching as discussed above to allow for the capability of processing web-based actions for exchanging information more efficient and effectively.

Conclusion

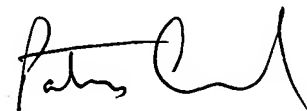
48. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walsh et al. (US PGPub 2003/0114174) mobile telephone short text messaging with message thread identification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to La Juania N. Mouzon whose telephone number is 571-270-3045. The examiner can normally be reached on Monday - Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Assouad can be reached on 571-272-2210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LNМ



**PATRICK ASSOUD
SUPERVISORY PATENT EXAMINER**